

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Brown et al.

Serial No: 10/042,491
Filed: 1/9/2002

Title: UTILIZING DOCUMENT
WHITE SPACE TO
PERSISTENTLY DISPLAY
DESIGNATED CONTENT

Docket Number:
AUS920010970US1

Before Examiner:
Oanh L Duong
Group Art Unit: 2155

IBM Corporation
c/o Amy J. Pattillo
P.O. Box 161327
Austin, TX 78716
512-402-9820

APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Briefs - Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This Appeal Brief is submitted in support of the Appeal in the above-referenced application pursuant to a Notice of Appeal filed May 16, 2007 as required by 37 C.F.R. 41.31. This is an appeal from a final rejection dated February 21, 2007 of Claims 1-27 of application serial number 10/042,491, filed 1/9/2002.

I. Real Party in Interest

The real party in interest in the present application is the Assignee, International Business Machines Corporation of Armonk, New York, as evidenced by the Assignment set forth at Reel 012473, Frame 0666.

II. Related Appeals and Interferences

There are no Appeals or Interferences known to Appellant, Appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. No decisions have been rendered by a court or the Board in any related applications.

III. Status of Claims

1. Status of All Claims in Application
 - a. Claims Rejected: 1-27
 - b. Claims Allowed or Confirmed: None
 - c. Claims Withdrawn from Consideration: None
 - d. Claims Objected to: None
 - e. Claims Cancelled: 28-30
2. Claims on Appeal
 - a. The claims being appealed are: 1-27.
 - b. The claims being appealed stand finally rejected as noted by the Examiner in the Examiner's Action dated February 21, 2007.
These rejected claims which form the basis of this appeal are reproduced in the attached Appendix.

IV. Status of Amendments

The Examiner finally rejected claims 1-30 in a final office action dated November 1, 2006. In particular, the final office action dated November 1, 2006 rejected claims 1-4, 7, 8, 12, 13, 15, 16, 19, 20, 22, 24, 26, and 27 under 35 U.S.C. §103(a) as being obvious over Huat (US Publication 2002/0133565) in view of Beranek (US Patent 6,886,013). Appellants filed an amendment after final, canceling claims 28-30 and providing evidence of common ownership to disqualify Beranek as prior art available under 35 USC 103(a). The Examiner issued a new final rejection of claims 1-28 in a final office action dated February 21, 2007. The final office action dated February 21, 2007 rejects claims 1-4, 7, 8, 12, 13, 15, 16, 19, 20, 22, 24, 26, and 27 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) alone. No amendments to the claims were made following the final office action dated February 21, 2007.

V. Summary of Claimed Subject Matter

Claim 1 is directed to a method for rendering a document on a display utilizing a viewer program running on a computer system. (Specification, paragraph 0023). The viewer program receives the primary content of the document to be displayed. (Specification, paragraphs 0023, 0032, 0040, 0049, Figure 3, element 302). The viewer program identifies secondary content to be displayed in conjunction with the primary content. (Specification, paragraphs 0023, 0032, 0049, Figure 1, element 101). The viewer program determines whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content. (Specification, paragraphs 0023, 0043-0046, 0049, 0051, 0052, Figure 1, element 102, Figure 3, elements 311, 312, and 313). The viewer program embeds the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content. (Specification, paragraphs 0023, 0049, Figure 3, element 322, 324). Responsive to determining the white space is not available, the viewer program reflows the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed. (Specification, paragraphs 0023, 0042, Figure 3, elements 322, 324).

Claim 2 is directed to the method of claim 1 and is further directed to the viewer program receiving a user action to change a portion of the primary content currently displayed in the display area, determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content, embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content, and responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed. (Specification, paragraphs 0023, 0042, 0049).

Claim 3 is directed to the method of claim 2, wherein the user action comprises at least one of a resizing of the display area and a scrolling of the primary content. (Specification, paragraph 0023)

Claim 4 is directed to the method of claim 1, wherein the white space is a background to the primary content. (Specification, paragraphs 0023, 0040).

Claim 5 is directed to the method of claim 1, wherein identifying secondary content is further directed to receiving a designation associated with receiving secondary content indicating that the secondary content is to be persistently displayed within white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area. (Specification, paragraphs 0023, 0040, 0052, 0055, 0056)

Claim 6 is directed to the method of claim 5, wherein receiving a designation is further directed to retrieving the designation from a database accessible to the viewer program. (Specification, paragraphs 0056, 0069)

Claim 7 is directed to the method of claim 1, wherein identifying secondary content is further directed to generating a viewer object containing the secondary content. (Specification, paragraphs 0040, 0055)

Claim 8 is directed to the method of claim 1 and is further directed to automatically resizing the secondary content to fill the determined white space. (Specification, paragraph 0041)

Claim 9 is directed to the method of claim 1, wherein the step of determining whether there is available white space is further directed to determining the areas of the data elements in the document used through a Document Object Model Interface. (Specification, paragraphs 0007, 0008, 0046, 0047, 0072, Figure 3, element 313)

Claim 10 is directed to the method of claim 1, wherein the step of reflowing the primary content is further directed to making changes to the Document Object Model tree and reflowing the document according to the changes. (Specification, paragraphs 0007, 0008, 0046, 0047, Figure 3, element 313)

Claim 11 is directed to the method of claim 1, wherein identifying secondary content to be displayed in conjunction with the primary content is further directed to identifying secondary content having a time based designation for causing at least one of i) an alternating of the display of the secondary content with other designated secondary content in a same white space, and ii) a displaying of the identified secondary content in the white space for only the time period specified. (Specification, paragraphs 0051, 0052, 0054, 0065)

Claims 12, 13, 14, 15, 16, 17, and 18 are directed to a computer program, on a nonvolatile or volatile computer readable medium, having program means for rendering a document on a display as described by the steps in claims 1, 2, 5, 7, 8, 11, and 9, respectively. (Specification, paragraphs 0037, 0038, 0075).

Claims 19, 20, 21, 22, 23, 24, and 25 are directed to a computer system running a viewer program having means for rendering a document on display as described by the steps in claims 1, 2, 5, 7, 6, 8, and 9, respective. (Specification, paragraphs 0034, 0035, Figure 2).

Claim 26 is directed to a method for sending a rendered document from a server to a client over a network. (Specification, paragraphs 0023, 0038, 0073). Primary content of the document to be displayed is received. (Specification, paragraphs 0023, 0032, 0040, 0049, Figure 3, element 302). Secondary content to be displayed in conjunction with the primary content is identified. (Specification, paragraphs 0023, 0032, 0049, Figure 2, element 101, Figure 3, element 302). A determination is made whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content. (Specification, paragraphs 0023, 0043-0046, 0049, 0051, 0052, Figure 1, element 102, Figure 3, elements 311, 312, and 313). The secondary content is embedded in the available white space if it is determined that there is available white space to accommodate the secondary content. (Specification, paragraphs 0023, 0049, Figure 3, element 322, 324). Responsive to a determination made that white space is not available, the primary content is reflowed to form suitable white space in the display area and the secondary content is embedded in the suitable white space formed.

(Specification, paragraphs 0023, 0042, Figure 3, elements 322, 324). The document is sent with the embedded secondary content to the client for display. (Specification, paragraphs 0038, 0039, 0073, Figure 2, elements 10, 38, 39).

Claim 27 is directed to a computer system having means for sending a rendered document to a client over a network as described in the steps of claim 26. (Specification, paragraphs 0034, 0035, Figure 2).

VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1, 2, 3, 4, 7, 8, 12, 13, 15, 16, 19, 20, 22, 24, 26, and 27 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565).
2. Claims 5, 15, and 21 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Porter (US Publication 2003/0052923).
3. Claims 6 and 23 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Porter (US Publication 2003/0052923) and Shema et al. (US 2002/0194190).
4. Claims 9, 18, and 25 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Mitchell et al. (US Patent 6,983,331).
5. Claim 10 stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Appellants Admitted Prior Art (AAPA).
6. Claims 11 and 17 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Ballard (US Patent 6,182,050).

VII. Argument

1. 35 U.S.C. 103(a), Alleged Obviousness under Huat, Claims 1, 3, 4, 7, 8, 12, 15, 16, 19, 22, 24, 26, and 27

The Final Office Action rejects claims 1, 3, 4, 7, 8, 12, 15, 16, 19, 22, 24, 26, and 27 under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565). [Final Office Action, p. 2] 35 U.S.C. §103(a) states that "a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Appellants traverse the rejection of the claims as not obvious under 35 U.S.C. §103(a). In addition, Appellants respectfully assert that the claims do not all stand or fall together.

Claims 1, 12, and 19

Claim 1, which is representative of claims 12 and 19 reads:

1. A method for rendering a document on a display utilizing a viewer program running on a computer system, comprising:
 - receiving primary content of the document to be displayed;
 - identifying secondary content to be displayed in conjunction with the primary content;
 - determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content;
 - embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
 - responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.

The Final Office Action cites Huat as reading on receiving primary content of the document to be displayed in paragraph 0034; identifying secondary content to be

displayed in conjunction with the primary content in paragraph 0039; determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content in paragraph 0042 and in the statement "Huat teaches it is determined whether an adequate clear space exists for displaying an intermediate message (i.e. secondary content); embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content in paragraph 0042 and in the statement "if a clear space exists, an intermediate message is displayed in this area"; embedding the secondary content in suitable white space formed in paragraph 0045 and the statement "displaying intermediate messages in the clear space of a scrolled/reflowed web page." [Final Office Action, pp. 2-3] The Office Action states that Huat does not explicitly teach responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area. [Final Office Action, p. 3] Instead, the Office Action cites that Huat, paragraph 0043 as describing

"it is determined that clear space is not available within the active window (i.e. in responsive to determining the white space is not available), it waits for a change in the active window that may create the available of clear/white space within the window, wherein such a change could be the scrolling of the web page within the display area to create the available clear/white space to display the additional content (i.e. the intermediate message)." [Final Office Action, p. 3]

The Office Action concludes that one of ordinary skill in the art at the time of the present invention would have readily found that Huat's disclosed mechanism for "scrolling of a web page within the display area to create the availability clear/white space" is substantially equivalent to "reflowing the primary content to form suitable white space in the displayed area" of the instant application. [Final Office Action, p. 3] Therefore, the Office Action concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the feature of "scrolling of a web page within the display area to create the available clear/white space" as "reflowing the primary content to form

suitable white space in the displayed area" as claimed. [Final Office Action, pp. 3-4]

As noted in the Office Action under 35 USC 103(a) a patent may not be obtained though the invention is not identically disclosed as described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. In *Graham v. John Deere*, the Supreme Court clarified that "under 103, in considering the obviousness or nonobviousness of the subject matter, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved, in addition to evaluating evidence of secondary considerations." *Graham*, 383 U.S. 1, 148 USPQ 459 (1966).

The Examiner bears the initial burden of supporting any *prima facie* conclusion of obviousness. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947, F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

First, Appellants respectfully assert that under a Graham inquiry, claims 1, 12, and 19 are not obvious in view of Huat because the differences between claims 1, 12, and 19 and Huat are such that the subject matter of claims 1, 12, and 19 as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter

pertains. Second, Appellants respectfully assert that the Final Office Action fails to establish a *prima facie* case of obviousness as to claims 1, 12, and 19.

Under the Graham Test, claims 1, 12, and 19 are not obvious under Huat

In considering the Graham test, Appellants respectfully assert that at least the element of responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed is not obvious under Huat when claims 1, 12, and 19 are considered as a whole. In particular, Appellants respectfully assert that the differences between this element and Huat are such that claims 1, 12, and 19 as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As to the scope and contents of Huat, Appellants note that the Office Action states that a person of ordinary skill in the art would find that Huat's "scrolling of a web page within the display area to create the availability clear/white space" in paragraph 0043 of Huat is substantially equivalent to "reflowing the primary content to form suitable white space in the displayed area."

[Final Office Action, pp. 3-4] Paragraph 0043 of Huat reads:

"If, in step 408, it is determined that clear space is not available within the active window, the clear space display process does not download and display the intermediate message. Instead, it waits for a change in the active window that may create the availability of clear space within the window, step 410. Such a change could be the reloading of another web page or the scrolling of a web page within the display area."

Thus, Huat describes that if clear space is not available within the display area, to wait for the user to select different content for display within the display area. *Huat*, paragraph 0043. In particular, the only examples of "wait for changes" provided in Huat are changes made by the user to display different content through reloading another web page or to scroll to a different portion of content displayed within the display area. *Huat*, paragraph 0043. Huat does not point to any "wait for changes" which wait for the browser or viewer program to adjust the

flow of currently displayed content within the display areas. In addition, Huat does not point to the browser or viewer program adjusting the layout of the current content to form additional space within the flow of the displayed content. In particular, when Huat is viewed as a whole, Huat's description of "it waits for a change in the active window that may create the availability of clear space within the window" describes checking, when different content is displayed within the display area due to a change in the active window, whether the changed content includes white space. This description in Huat of a change in the active window creating the availability of clear space does not teach a change in the active window creating the white space.

As to the differences between Huat and claims 1, 12, and 19, a first difference between Huat and claims 1, 12, and 19 is that claims 1, 12, and 19 teach reflowing the *content* to form white space *within the display area* and, in contrast, Huat describes waiting for the user to select to display *different content* within the display area, where the different content layout may include white space. *Huat*, paragraph 0043. Based on this difference alone, claims 1, 12 and 19, when viewed as a whole, would not be obvious to one within skill in the art of browser development because Huat only requires monitoring for changes in the content displayed within the display area and checking, when there are changes, whether there is suitable white space. In contrast, claims 1, 12, and 19 require not only checking whether there is white space within the display area, but if suitable white space is not available, require a browser configured to reflow content to form white space within the display area.

Appellants note that in determining the differences between the prior art and the claims, the question under 35 USC 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). In addition, in determining whether the invention as a whole would have been obvious under 35 USC 103, one looks not only to the subject matter which is literally recited in the claim in question, but also to those properties of the subject matter which are inherent in the subject

matter and are disclosed in the specification. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977).

As to a second difference between Huat and claims 1, 12, and 19, Appellants assert that where claims 1, 12, and 19 teach reflowing the primary to form white space within the display area, reflowing content and forming white space within the display area have the inherent properties of readjusting the underlying layout of the content (reflowing the content) to add white space to the layout within the display area (to form white space within the display area). The inherent properties of reflowing by readjusting the underlying layout of the primary content and forming white space by adding white space to the layout within the display area are clearly disclosed in the specification of the present invention in paragraphs 0023, 0042, 0048, 0051, 0052, and 0070. Thus, the difference between Huat and claims 1, 12, and 19, when claims 1, 12, and 19 are considered as a whole including inherent properties of the claimed elements which are disclosed in the specification, is that claims 1, 12, and 19 teach adjusting the layout of primary the content to form a new space within the display area and, in contrast, Huat describes checking whether a current display area includes white space, and if it does not include white space, waiting for the user to select to display different content within the display area where by virtue of the different content including white space, the different content may "create the availability" of white space within the display area.

Appellants respectfully assert that it would not be obvious to one with skill in the art of browser development to adjust Huat's system of checking whether the currently displayed content includes sufficient white space, and if not, waiting until the user changes the display to include different content which may create the availability of different white space, even if through scrolling, to instead teach adjusting the underlying layout of the content within the display area to *form* white space within that display area. Such an adjustment would require the browser, on the fly, to not merely check whether there is sufficient white space within the display interface and if not, wait until a user triggered change occurs to display different content, but instead the adjustment to Huat would require the

browser in Huat to actually adjust the layout of the primary content within the display to form white space, as is taught in claims 1, 12, and 19.

In addition, even if reflowing primary content to form suitable white space within the display area were not considered to have the inherent properties of adjusting a layout of the primary content to actually form white space within that layout within the display area, the Final Office Action states an overly broad interpretation of the claims and does not give meaning to the terms reflowing content to form white space. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ 1827, 1834 (Fed. Cir. 2004). This means that the words in the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In particular, Appellants respectfully assert that it is overly broad to interpret claims 1, 12, and 19, which teach checking whether there is suitable white space within a display area and, if there is suitable white space, embedding the content in the white space, and if there is not suitable white space, reflowing content to form that suitable white space, as only describing, responsive to a change in the display area, such as a user scrolling, checking whether the change to a different portion of content within the display area has created the availability of white space. Since claims 1, 12, and 19 already describe checking the availability of white space responsive to a change to the display window, the interpretation in the Final Office Action that reflowing and forming white space are substantially equivalent to checking the availability of white space within the display area not only does not give the words reflowing or to form white space their plain meanings, as asserted above, but does not give these words any meaning.

In addition, Appellants note that in determining whether the claimed invention as a whole would have been obvious, a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Huat describes that if no white space is found, then the browser waits until a user scrolls to a different portion of content within the display area and then checks again whether there is white space available. *Huat*, paragraph 0043. Huat not only does not teach reflowing content within the display area to form white space, but Huat describes waiting for a user to scroll the web page to different content, not actively reflowing content or forming the white space area. This difference alone, when considering both claims 1, 12, and 19 as a whole and Huat as a whole, indicates that one with skill in the art of browser development, if considering Huat, would only consider it obvious to modify Huat to include "wait for changes" performed by a user in addition to a user scrolling or a user selecting a new web page. One with skill in the art of browser development would not find it obvious to modify Huat, instead of waiting for changes, to proactively change the flow of content within the display area and to form white space within the display area.

In view of the foregoing, it is clear that claims 1, 12, and 19 are not obvious under Huat under the requirements of 35 USC 103(a) as applied in a Graham inquiry, and the claims should be allowed.

A prima facie case of obviousness is not established as to claims 1, 12, and 19

As to the Examiner's burden of proving a prima facie case of obviousness, Appellants respectfully assert that a prima facie case of obviousness is not established under Huat as to claims 1, 12, and 19 and therefore the claims should be allowed. To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Appellants respectfully submit that there is no suggestion or motivation explicitly or implicitly in Huat or in the knowledge generally available to one of ordinary skill in the art to modify Huat to teach each and every elements of claims 1, 12, and 19 and therefore the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims.

The Final Office Action asserts that "one of ordinary skill in the art at the time of the present invention would have readily found that Huat's disclosed mechanism for "scrolling of a web page within the display area to create the availability clear/white space" is substantially equivalent to "reflowing the primary content to form suitable white space in the display area" of the instant application." [Office Action, pp. 3-4] Appellants disagree with this statement of equivalence and respectfully assert that there is no suggestion or motivation in Huat or the knowledge of one with skill in the art to modify Huat to find the equivalence and that such a suggestion is merely an impermissible use of hindsight occasioned by Appellants' own teachings.

Claims 1, 12, and 19 teach reflowing primary content to form suitable white space in the display area. Reflowing primary content to form white space, if each word of the claims is given meaning by one with skill in the art of browser development, clearly requires an adjustment of the layout of the primary content to actually form white space within the primary content within the display area. Furthermore, paragraph 0023 of the specification of the present invention clearly distinguishes between reflowing the primary content to form suitable white space within the display area and a user scrolling to show a different portion of primary content within the web page; paragraph 0023 describes that in response to a

user scrolling to show a different portion of primary content within the display window, if there is not already suitable white space within the different portion, that portion is reflowed to form suitable white space within the display window.

As previously noted, paragraph 0023 of Huat describes that if clear space is not available within the display area, the system waits for the user to select different content for display within the display area. *Huat*, paragraph 0043. In particular, the only examples of "wait for changes" provided in Huat are changes made by the user to display different content through reloading another web page or scrolling to a different portion of content displayed within the display area. *Huat*, paragraph 0043. In Huat, the scrolling of a web page within a display area triggers the browser to check whether space is available in the new content displayed within the display area.

While the Final Office Action states that Huat's disclosed mechanism describes "scrolling of a web page within the display area to create the availability of clear/white space," is the functional equivalent of reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed clearly, one of ordinary skill in the art of browser development, when viewing Huat's as a whole, would find Huat to describe a system of checking, responsive to a user scrolling a web page, whether there is now white space available in the display area. The only thing "created" in Huat by a user scrolling through a web page is the possibility that the web page may be scrolled to a portion where the content layout already include suitable white space, and thus the scrolling creates potential availability of white space. No portion of Huat nor in the knowledge generally available to one with skill in the art, would find Huat's system as suggesting or motivating modification of a browser application to adjust the layout of the content to form suitable white space within the display area, as taught in claims 1, 12, and 19.

Therefore, because Huat's "scrolling of a web page within the display area to create the availability of clear/white space" would clearly not be found by with skill in the art as substantially equivalent to the claimed element of reflowing the primary content to form suitable white space in the displayed area, this assertion

in the Final Office Action as to substantial equivalence is instead an impermissible use of hindsight, occasioned by Appellants' own teaching, to reject the claims. Because there is no suggestion or motivation for modifying Huat to teach an equivalent of reflowing the primary content to form suitable white space in the displayed area a prima facie case of obviousness is not established. Because prima facie obviousness is not established, Appellants respectfully request withdrawal of the rejection and allowance of claims 1, 12, and 19.

Furthermore, Appellants note that in a Final Office Action dated November 1, 2006, the Examiner previously finally rejected claims rejected claims 1, 12, and 19 under 35 U.S.C. §103(a) as being obvious over Huat (US Publication 2002/0133565) in view of Beranek (US Patent 6,886,013). In particular, Final Office Action dated November 1, 2006, stated that paragraph 0043, and the description that "it waits for a change in the active window or web page that may create the availability for clear space within the window" only read on the element of responsive to determining that white space is not available. In addition, the Final Office Action dated November 1, 2006, stated that Huat does not explicitly teach reflowing the primary content to form suitable white space in the displayed area and embedding the secondary content in the suitable white space formed, but relied instead on Beranek as teaching this element. Appellants filed an amendment after final, providing evidence of common ownership to disqualify Beranek as prior art available under 35 USC 103(c). In fact, the Examiner provided notice to Appellants in the Final Office Action dated November 1, 2006 that Appellants were required to provide evidence of common ownership, since the present application and Beranek clearly have the same assignee. Shifting positions, the Examiner issued a new final rejection of claims 1, 12, and 19 in a final office action dated February 21, 2007 under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) alone. While Appellants note that an Examiner may reevaluate the application of a reference, Appellants respectfully assert that as presented in the previous Final Office Action dated November 1, 2006, Huat does not teach nor suggest, nor would one with skill in the art find Huat's teachings as a substantial equivalent to, reflowing

the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.

Claims 2, 13, and 20

Appellants respectfully assert that because claims 2, 13, and 20 are dependent upon claims 1, 12, and 19, for which the Examiner has not proved a prima facie case of obviousness, a prima facie case of obviousness is also not established with reference to claim 2, 13, and 20. Second, separately, Appellants respectfully assert that the Examiner has not proved a prima facie case of obviousness with respect to claims 2, 13, and 20 and therefore the claims do not all stand or fall together.

Claim 2, which is representative in subject matter of claims 13 and 20, reads:

2. The method of claim 1 further comprising:
 - receiving a user action to change a portion of the primary content currently displayed in the display area;
 - determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content; and
 - embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
 - responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.

In the rejection of claims 2, 13, and 20, the Office Action cites Huat's description of "scrolling of a web page within the display area" in paragraph 0043 as reading on receiving a user action to change a portion of the primary content currently displayed in the display area. [Final Office Action, p. 4] In addition, the Office Action cites paragraph 0042 of Huat as reading on determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content and embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content.

[Final Office Action, p. 4] The Office Action states that Huat does not teach responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed, but states the same reasoning as previously stated with respect to claims 1, 12, and 19 as to why Huat as modified teaches the element. [Final Office Action, p. 5]

First, in establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Appellants note that the rejection of claims 2, 13, and 20 relies on Huat's description of a user scrolling a web page in the display area as teaching receiving a user action to change a portion of the primary content currently displayed in the display area and Huat's description of a waiting for a user to scroll through a window to a different portion which may create the availability of white space as a functional equivalent of reflowing the primary content to form suitable white space in the display area. Claims 2, 13, and 20, when considered as a whole, teaches receiving the user action to change the portion of the primary content displayed within the display interface, and in response to the change, determining whether there is suitable white space within the display area. Similarly, Huat describes receiving the user action of scrolling to change the portion of content displayed within the display interface, and in response to the change, determining whether there is suitable white space in the display area. However, at this point, Huat and claims 2, 13, and 20 teach different inventions which are not substantially equivalent. Claims 2, 13, and 20, teach that if there is not suitable white space after the scrolling, then the primary content is reflowed to form suitable white space. In contrast, Huat describes, that if there is not suitable white space after the scrolling, waiting to receive a user action changing the portion of primary content displayed in the display area.

Clearly, Huat's description in paragraphs 0042 and 0043 of detecting a user scroll a web page and checking whether the scrolling created the available of space in the current portion of the web page, is only applicable, if at all, to the

elements of receiving a user action to change a portion of the primary content currently displayed in the display area and determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content. The description in Huat in paragraph 0043 of waiting for the user to scroll the web page, when there is not sufficient white space in the page, where the scrolling may create the availability of space in a different portion of the web page does not trigger any action other than waiting to receive a user action to change a portion of the primary content currently displayed in the display area and then again determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content. No portion of Huat, and in particular, the description in Huat as asserted in the Final Office Action of "scrolling of a web page within the display area to create the availability clear/white space" triggers, after a user has scrolled to change the portion of primary content currently displayed in the display area, triggers any action to adjust the flow of the content to actually form the white space in the primary content currently displayed in the display area. Because no portion of Huat triggers any action, responsive to not detecting suitable white space, other than waiting for a user action to change the portion of primary content and checking whether suitable white space is available, Huat's "scrolling of a web page within the display area to create the availability clear/white space does not teach, and is not substantially equivalent to reflowing the primary content to form suitable white space in the display area. Because Huat does not teach or suggest each and every element of claims 2, 13, and 20, when claims 2, 13, and 20 are considered as a whole, the Final Office Action fails to establish a prima facie case of obviousness as to claims 2, 13, and 20 and the claims should be allowed.

In addition, to establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Chen by Chang. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Appellants respectfully assert that there is no reasonable expectation of success in the modification of Huat to teach each and every element of claims

2, 13, and 20. Huat describes receiving a user action of scrolling to change the portion of the primary content displayed in the display area, and responsive to the change, checking if the change in the portion of the web page displayed creates the availability of white space within the window, but if there is not suitable white space within the window, waiting for the user to scroll the web page again. Claims 2, 13, and 20 teach receiving a user action of scrolling to change the portion of the primary content displayed in the display area, and responsive to the change, checking for the availability of white space within the window, but, if there is not suitable white space within the window, reflowing the primary content to form the suitable white space. Huat does not teach any action, responsive to the content currently displayed not including suitable white space, other than waiting for the user to scroll. Therefore, there is no reasonable expectation of success in the proposed modification of Huat from teaching, when there is not suitable white space, instead of waiting for a next user action, to automatically reflow the displayed content and form white space within the display area. Because there is not a reasonable expectation of success in the proposed modification of Huat to teach claims 2, 13, and 20, the Final Office Action fails to prove a prima facie case of obviousness as to claims 2, 13, and 20 and the claims should be allowed.

Claims 3, 4, 7, 8, 15, 16, 22, 24, 26, and 27

Appellants respectfully assert that because claims 3, 4, 7, 8, 15, 16, 22, 24, 26, and 27 are dependent upon claims 1, 12, and 19 for which the Examiner has not proved a prima facie case of obviousness, a prima facie case of obviousness is also not established with reference to claims 3, 4, 7, 8, 15, 16, 22, 24, 26, and 27.

2. 35 U.S.C. 103(a), Alleged Obviousness under Huat in view of Porter, Claims 5, 15, and 21

The Final Office Action rejects claims 5, 15, and 21 under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication

2002/0133565) in view of Porter (US Publication 2003/0052923). [Final Office Action, p. 10] Appellants respectfully assert that because claims 5, 15, and 21 are dependent upon claims 1, 12, and 19, for which the Examiner has not proved a *prima facie* case of obviousness, a *prima facie* case of obviousness is also not established with reference to claims 5, 15, and 21.

In addition, Appellants respectfully assert that the Examiner has not separately proved a *prima facie* case of obviousness with respect to claims 5, 15, and 20 and therefore the claims do not all stand or fall together. Claim 5, which is representative of claims 15 and 20, reads:

5. The method of claim 1 wherein identifying secondary content comprises receiving a designation associated with receiving secondary content indicating that the secondary content is to be persistently displayed within white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area.

The Final Office Action states that Huat teaches the method of claim 1, but does not teach any of the elements of claim 5. The Final Office Action relies on Porter as describing "a system wherein a persistently visible display of content including advertisements is provided (see in abstract)." Final Office Action, p. 10. The Final Office Action describes Porter's "by virtual of the browser's exclusive use of its assigned display area 506b or 506c, the advertisement rendered are persistently visible, independent of changes in the shared display area 504, Fig. 5, page 4, paragraph 0037" as reading on the claimed element of wherein identifying secondary content comprises receiving a designation associated with receiving secondary content indicating that the secondary content is to be persistently displayed within white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area. The Final Office Action concludes that

"it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Huat to identify secondary content comprises receiving secondary content indicating that the secondary content is to be persistently displayed

within white space within displayed area unless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of the displayed area as taught by Porter. One would be motivated to do so to overcome the prior art disadvantage of losing visibility to some of the rendered contents such as banner advertisement (Porter, page 2 paragraph 0019)." [Final Office Action, p. 11]

Appellants note that Porter describes a display surface divided into multiple display areas, including a shared display area (SDA) where any number of applications may render contents in their corresponding windows and one or more exclusive-use display areas (EDA), where only assigned applications may corresponding render contents into these areas. Porter, paragraph 0019. Paragraph 0036 describes that in Figure 5 of Porter, the EDA manager assigns an advertisement rendering program to EDAs 506b and 506c. In paragraph 0037, cited in the Final Office Action, Porter describes "it is assumed that the advertisements are constituted with Hypertext Mark-Up Language (HTML) pages, and each advertisement rendering program is an instance of a browser program, such as the Internet Explorer available from Microsoft or Navigator available from Netscape... By virtue of the browser's exclusive use of its assigned display area 506b or 506c, the advertisements rendered are persistently visible, independent of changes in the shared display area 504." [Final Office Action, p. 11]

Thus, Porter describes a display interface in which spaces within the display area are assigned as exclusive use spaces for particular applications, where the applications designate what to place in the EDA. Porter does not teach or suggest, nor does the combination of Huat and Porter teach or suggest each and every element of claims 5, 15, and 21 when viewed as a whole for several reasons.

First, Appellants note that claims 1, 12 and 19 upon which claims 5, 15, and 21 are dependent, teach that the white space is identified or formed within the primary content displayed within the display area. In contrast, Porter describes designated exclusive use spaces outside of the shared area where primary content would be rendered. Porter's description of an advertisement

rendering program, assigned to a particular exclusive space, rendering advertisements in that space that are not effected by changes in the shared display area does not teach or suggest secondary content designated for persistent display within the white spaces within the primary content of a display area. Therefore, Porter does not teach or suggest receiving secondary content designated for persistent display in any area other than exclusive areas designated separate from the display area which includes the primary content.

Second, Appellants note that Huat does not teach or suggest persistently displaying secondary content, but only describes, that if white space is available within a display area, secondary content may be displayed within the white space. In addition, Porter describes persistently displaying advertising, but only within exclusive use spaces, separated from the display area in which primary content would be displayed. Therefore the combination of Huat and Porter, teaches or suggests receiving secondary content designated for persistent display within white space within the display area where the white space is always identified or formed among the primary content within a display area.

Because neither Huat nor Porter, separately or in combination teaches or suggests each and every element of claims 5, 15, and 21, the Final Office Action fails to establish a *prima facie* case of obviousness as to claims 5, 15, and 21 and the claims should be allowed.

3. 35 U.S.C. 103(a), Alleged Obviousness under Huat in view of Porter and Shema, Claims 6 and 23

The Final Office Action rejects claims 6 and 23 under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Porter (US Publication 2003/0052923) and Shema et al. (US 2002/0194190) (herein referred to as Shema). [Final Office Action, p. 12] Appellants respectfully assert that because claims 6 and 23 are dependent upon claims 1 and 19, for which the Examiner has not proved a *prima facie* case of obviousness, a *prima facie* case of obviousness is also not established with reference to claims 6 and 23. In addition, Appellants respectfully assert that

because claims 6 and 23 are dependent upon claims 5 and 21, for which the Examiner has not proved a prima facie case of obviousness, a prima facie case of obviousness is also not established with reference to claims 6 and 23.

In addition, Appellants respectfully assert that the Examiner has not separately proved a prima facie case of obviousness with respect to claims 6 and 23 and therefore the claims do not all stand or fall together. To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Appellants respectfully submit that there is no suggestion or motivation explicitly or implicitly in Huat or in the knowledge generally available to one of ordinary skill in the art to modify Huat, Porter and Shema to teach each and every elements of claims 6 and 23 and therefore the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims.

Claim 6, which is representative of claim 23, reads:

6. The method of claim 5 wherein receiving a designation further comprises retrieving the designation from a database accessible to the viewer program.

The Final Office Action states that the combination of Haut and Porter does not

explicitly teach the elements of claims 6 and 23 but that Shema describes the elements in paragraph 0051. [Final Office Action, p. 12] The Final Office Action concludes that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Huat and Porter to retrieve the designation from a database accessible to the viewer program as taught by Shema. One would be motivated to do so to efficiently retrieve the database information regarding a designation associated with the secondary content." [Final Office Action, p. 12]

Appellants note that Shema describes "automated transformation of graphics into an enriched electronic display containing related reference designation links and access to information associated with the parts depicted in the graphic." Shema, paragraph 0002. Paragraph 0051 of Shema, cited in the Final Office Action, describes

"the intelligent graphic explorer 50 depicted in Fig. 3 may provide the interface for the functionality provided by the application system 34 and the intelligent graphic viewer 36. For example, the intelligent graphics viewer 36 may permit a user to view the graphic stored by the intelligent graphic file 32 and depicted in the intelligent graphics viewer display 60 of Fig. 3. the user may then choose to point to the item/part number reference designation "19" with the selection device, such as a mouse, and the intelligent graphic viewer 36 automatically presents the graphic as instructed in the APS. For example, for this item/part number reference designation, the APS instructs the intelligent graphic viewer 36 to magnify the reference designation "19" and display the textual part information associated with the reference designation "19"...."

Appellants note that the reference in paragraph 0051 to application system 34 seems to refer to an application system in Figure 1 of Shema which includes a database management system and an intelligent graphics viewer which accesses the database management system and an intelligent graphics file. Regardless of whether Shema describes a viewer program which accesses a database, Shema describes a viewer program accessing a database to permit a viewer to select a part displayed in a graphic by the viewer program and access information associated with the part from the database or file.

No portion of Shema suggests or motivates modification of Shema's viewer which accesses a database for enabling viewing of additional information about graphics when selected by the user to instead teach a viewer which accesses a database which specifies which content is designated as secondary content to be persistently displayed. In addition, no portion of Huat or Porter suggests or motivates modification of these references to teach the browser, or viewer program, accessing a database to determine which content is designated as secondary content.

The Examiner cannot merely combine Shema which describes a viewer program which accesses a database for providing additional information about a graphic part with another viewer program in Huat or Porter and conclude that there is suggestion or motivation for modifying the viewer program in Shema to instead access a database to determine whether content is to be persistently displayed and then also modifying Huat and Porter to teach a viewer program which accesses the database to determine whether content is to be persistently displayed. Because neither Huat, Porter or Shema point to a suggestion or motivation for modification to teach wherein receiving a designation further comprises retrieving the designation from a database accessible to the viewer program and there is no indication why one of ordinary skill in the art would find it obvious to modify Shema and then to further modify Huat and Porter by Shema, the Examiner's proposal of the combination of these references teaching the elements of claims 6 and 23 is an impermissible use of hindsight, occasioned by Appellants' own teachings. Because the only basis of obviousness in the proposed rejection of claims 6 and 23 is improper hindsight, the Final Office Action fails to prove a *prima facie* case of obviousness as to claims 6 and 23 and the claims should be allowed.

4. 35 U.S.C. 103(a), Alleged Obviousness under Huat in view of Mitchell, Claims 9, 18, and 25

The Final Office Action rejects claims 9, 18, and 25 under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication

2002/0133565) in view of Mitchell et al. (US Patent 6,983,331) (herein referred to as Mitchell. [Final Office Action, p. 13] Appellants respectfully assert that because claims 9, 18, and 25 are dependent upon claims 1, 12, and 19, for which the Examiner has not proved a prima facie case of obviousness, a prima facie case of obviousness is also not established with reference to claims 9, 18, and 25.

5. 35 U.S.C. 103(a), Alleged Obviousness under Huat in view of AAPA, Claims 10

The Final Office Action rejects claim 10 under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Appellants Admitted Prior Art (AAPA). [Final Office Action, p. 14] Appellants respectfully assert that because claims 10 is dependent upon claim 1, for which the Examiner has not proved a prima facie case of obviousness, a prima facie case of obviousness is also not established with reference to claim 10.

In addition, Appellants respectfully assert that the Examiner has not separately proved a prima facie case of obviousness with respect to claim 10 and therefore the claims do not all stand or fall together. To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871

F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Appellants respectfully submit that there is no suggestion or motivation explicitly or implicitly in Huat or in the knowledge generally available to one of ordinary skill in the art to modify Huat by AAPA to teach each and every elements of claim 10 and therefore the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claim.

Claim 10 teaches:

10. The method of claim 1 wherein the step of reflowing the primary content further comprises making changes to the Document Object Model tree and reflowing the document according to the changes.

The Final Office Action states that Huat does not teach the elements of claim 10, but cites AAPA as describing "the browser reflows the document according to the change made to the DOM tree as the reflowed document is rendered to the display" and as reading on wherein the step of reflowing the primary content further comprises making changes to the Document Object Model tree and reflowing the document according to the changes. [Final Office Action, p. 14] In addition, the Final Office Action states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Huat to make changes to the document Object Model tree and reflowing the document according to the changes as in APA. One would be motivated to do so to allow programs and scripts to dynamically access and update the content, structure, and style of the document." [Final Office Action, p. 14]

Appellants respectfully assert that for there to be motivation for modifying Huat by AAPA to teach wherein the step of reflowing the primary content further comprises making changes to the Document Object Model tree and reflowing the document according to the changes, there would first have to be modification for modifying Huat to teach reflowing the primary content by adjusting the structure of underlying content. As previously noted with regard to the rejection of claim 1, there is no suggestion or motivation for modifying Huat to teach reflowing primary content, in particular where reflowing the primary content would require adjusting the underlying structure of the primary content. Therefore, there is no motivation

or suggestion, either in Huat or the knowledge of one of ordinary skill in the art, for both modifying Huat to suggest reflowing primary content and for further modifying Huat to perform the reflowing of primary content by making changes to the DOM tree which specifies the underlying structure of the document and reflowing the document according to the changes in the DOM tree. Because there is no motivation or suggestion either in Huat or AAPA or within the knowledge of one of ordinary skill in the art at the time of the invention to modify Huat to teach reflowing primary content and further to modify Huat to teach reflowing primary content by making changes to the Document Object Model tree and reflowing the document according to the changes, the Examiner's proposal of the combination of these references teaching the elements of claim 10 is an impermissible use of hindsight, occasioned by Appellants' own teachings. Because the only basis of obviousness in the proposed rejection of claim 10 is improper hindsight, the Final Office Action fails to prove a *prima facie* case of obviousness as to claim 10 and the claim should be allowed.

6. 35 U.S.C. 103(a), Alleged Obviousness under Huat in view of Ballard, Claims 11 and 17

The Final Office Action rejects claims 11 and 17 under 35 U.S.C. §103(a) as being allegedly unpatentable over Huat (US Publication 2002/0133565) in view of Ballard (US Patent 6,182,050). [Final Office Action, p. 14] Appellants respectfully assert that because claims 11 and 17 are dependent upon claims 1 and 12, for which the Examiner has not proved a *prima facie* case of obviousness, a *prima facie* case of obviousness is also not established with reference to claims 11 and 17.

CONCLUSION

It is therefore respectfully requested that the Examiner's rejection of claims 1-27 under 35 U.S.C. §103(a) be reversed and the claims allowed.

Please charge the fee of \$500.00 for submission of an Appeal Brief under 37 CFR 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0447. No

additional filing fee is believed to be necessary; however, in the event that any additional fee is required, please charge it to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

By /Amy J. Pattillo, Reg. No. 46,983/

AMY J. PATTILLO

Registration No. 46,983

P.O. BOX 161327

AUSTIN, TEXAS 78716

ATTORNEY FOR APPELLANTS

Telephone: 512-402-9820

Facsimile: 512-306-0417

VIII. Claims Appendix

The Claims involved in the Appeal are as follows:

1. A method for rendering a document on a display utilizing a viewer program running on a computer system, comprising:

- receiving primary content of the document to be displayed;
- identifying secondary content to be displayed in conjunction with the primary content;
- determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content;

- embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and

- responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.

2. The method of claim 1 further comprising:

- receiving a user action to change a portion of the primary content currently displayed in the display area;

- determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content; and

- embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and

- responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.

3. The method of claim 2 wherein the user action comprises at least one of a resizing of the display area and a scrolling of the primary content.
4. The method of claim 1 wherein the white space is a background to the primary content.
5. The method of claim 1 wherein identifying secondary content comprises receiving a designation associated with receiving secondary content indicating that the secondary content is to be persistently displayed within white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area.
6. The method of claim 5 wherein receiving a designation further comprises retrieving the designation from a database accessible to the viewer program.
7. The method of claim 1 wherein identifying secondary content comprises generating a viewer object containing the secondary content.
8. The method of claim 1 further comprising automatically resizing the secondary content to fill the determined white space.
9. The method of claim 1 wherein the step of determining whether there is available white space further comprises determining the areas of the data elements in the document used through a Document Object Model Interface.
10. The method of claim 1 wherein the step of reflowing the primary content further comprises making changes to the Document Object Model tree and reflowing the document according to the changes.

11. The method of claim 1 wherein identifying secondary content to be displayed in conjunction with the primary content further comprises identifying secondary content having a time based designation for causing at least one of i) an alternating of the display of the secondary content with other designated secondary content in a same white space, and ii) a displaying of the identified secondary content in the white space for only the time period specified.

12. A computer program, on a nonvolatile or volatile computer readable medium, having program code means for rendering a document on a display, comprising:

- means for receiving primary content of the document to be displayed;
- means for identifying secondary content to be displayed in conjunction with the primary content;
- means for determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content;
- means for embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
- means, responsive to determining the white space is not available, for reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.

13. The computer program of claim 12 further comprising:
 - means for identifying a user action to change a portion of the primary content currently displayed in the display area;
 - means for determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content;
 - means for embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
 - means, responsive to determining the white space is not available, for reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.
14. The computer program of claim 12 wherein the means for identifying secondary content further comprises means for receiving a designation associated with receiving secondary content indicating that the secondary content is to be persistently displayed within white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area.
15. The computer program of claim 12 wherein the means for identifying secondary content comprises means for generating a viewer object containing the secondary content.
16. The computer program of claim 12 further comprising means for automatically resizing the secondary content to fill the determined white space.

17. The computer program of claim 12 wherein means for identifying secondary content to be displayed in conjunction with the primary content further comprises means for identifying secondary content having a time based designation for causing at least one of i) an alternating of the display of the secondary content with other designated secondary content in a same white space, and ii) a displaying of the identified secondary content in the white space for only the time period specified.
18. The computer program of claim 12 wherein the means for determining whether there is available white space further comprises means for determining the areas of the data elements in the document used through a Document Object Model Interface.
19. A computer system running a viewer program having means for rendering a document on a display, comprising:
 - means for receiving primary content of the document to be displayed;
 - means for identifying secondary content to be displayed in conjunction with the primary content;
 - means for determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content;
 - means for embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
 - means, responsive to determining the white space is not available, for reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.

20. The computer system of claim 19 further comprising:
 - means for identifying a user action to change a portion of the primary content currently displayed in the display area;
 - means for determining whether there is available white space within the portion of primary content currently displayed in the display area to accommodate the secondary content;
 - means for embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content; and
 - means, responsive to determining the white space is not available, for reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed.
21. The computer system of claim 19 wherein the means for identifying secondary content further comprises means for receiving a designation associated with receiving secondary content indicating that the secondary content is to be persistently displayed within white space within the display area regardless of a user action of at least one of adjusting the portion of the primary content currently displayed within the display area and adjusting a size of said display area.
22. The computer system of claim 19 wherein the means for identifying secondary content comprises means for generating a viewer object containing the secondary content.
23. The computer system of claim 19 wherein the means for receiving a designation further comprises means for retrieving the designation from a database accessible to the viewer program.
24. The computer system of claim 19 further comprising means for automatically resizing the secondary content to fill the determined white space.

25. The computer system of claim 19 wherein the means for determining whether there is available white space further comprises means for determining the areas of the data elements in the document used through a Document Object Model Interface.

26. A method for sending a rendered document from a server to a client over a network, comprising:

- receiving primary content of the document to be displayed;
- identifying secondary content to be displayed in conjunction with the primary content;
- determining whether there is available white space within the primary content, when displayed within a display area, to accommodate the secondary content;
- embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content;
- responsive to determining the white space is not available, reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed; and
- sending the document with the embedded secondary content to the client for display.

27. A computer system having means for sending a rendered document to a client over a network, comprising:

- means for receiving primary content of the document to be displayed;
- means for identifying secondary content to be displayed in conjunction with the primary content;
- means for determining whether there is available white space within the primary content, when displayed within a displayable area, to accommodate the secondary content;
- means for embedding the secondary content in the available white space if it is determined that there is available white space to accommodate the secondary content;
- means, responsive to determining the white space is not available, for reflowing the primary content to form suitable white space in the display area and embedding the secondary content in the suitable white space formed; and
- means for sending the document with the embedded secondary content to the client for display.

IX. Evidence Appendix

There is no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner that is relied upon by Appellants in the appeal.

X. Related Proceedings Appendix

There are no decisions rendered by a court or the Board in any related appeals.